

REMARKS/ARGUMENTS

Claims 2-16, 18-30 and 32-48 are pending in this application. Applicants have thoroughly reviewed the Office Action and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the claims are believed to be patentable over the cited references.

CLAIM REJECTIONS – 35 U.S.C. § 101

The Examiner stated that with regard to claims 2-16, 18-30 and 32-48, the methods recited in the claimed invention do not produce a real world, useful, concrete and tangible result.

Respectfully, the Examiner has failed to provide a *prima facie* case for a 35USC101 rejection. It is the burden of the Examiner to first make a *prima facie* showing and the Examiner has only made a statement that the claims are rejected under 35USC101 and statements concerning the guidelines were made, but no reference to the claims specifically were made by the Examiner or a specific reason why the claims are rejectable under 35USC101 as related to claims other than stating that the claims in general do not provide a real life, real world, useful, concrete and tangible results.

However, for the sake of argument, without admission as to the *prima facie* case, the following statements are made to show the impropriety of the rejection.

Respectfully, claim 2 concerns an apparatus claim with a device comprising an apparatus detached from equipment and a hardware controller attached to the equipment. An apparatus

claim falls within one of the enumerated categories for 35USC101. The Examiner mentions that manipulation of an abstract idea is not concrete or tangible. However, the physical parts mentioned in claim 2 as mentioned above are clearly not abstract, but tangible and concrete. As mentioned even in the guidelines of 101 by USPTO, “the claim must be examined to see if it includes anything more than a Sec. 101 judicial exception.” However, it is clear that the claim is within the statutory class and not in the exception.

Respectfully, the guidelines mentioned by the Examiner, however, are not the law but merely a guideline as even mentioned within the guidelines.

The claim even states that the device provides diagnostic and control for equipment. The hardware controller monitors the equipment through a communication device. Therefore, claim 2 produces a real world, useful, concrete and tangible result. Moreover, claims 3-16 depend on claim 2 and therefore also produce a real world, useful, concrete and tangible result.

Concerning claims 18-30, in the independent claim 18, the claim states of diagnostic and control capabilities, where the equipment is monitored and there is even a storing of the identifier. A useful, concrete and tangible result is clearly shown.

Claims 32-48 include a remote means and a means for determining the status of the equipment in order to provide diagnostic and control capabilities. Clearly controlling equipment is a concrete and tangible result that is useful. The examiner cannot reject the above claims for any particular section of the claims only, because the claims must be looked as a whole. As mentioned in the guidelines provided by the Examiner, “USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209

USPQ 1, 9 (1981). When evaluating the scope of a claim, every limitation in the claim must be considered. MPEP §2106.

Therefore, even if a portion of the claims is in question, that does entail the entire claim being without a useful, concrete and tangible result. Therefore, it is clear that the remaining claims 32-48 also include statutory subject matter and include a useful, concrete and tangible result. As seen above, a remote means and a means for determining the status of the equipment in order to provide diagnostic and control capabilities is claimed is not a manipulation of an abstract idea. Furthermore, the claim states that the device provides remote diagnostic and control capability for equipment which is clearly a useful, concrete and tangible result.

Therefore, as shown above, the 35USC101 rejection should be removed.

CLAIM REJECTIONS – 35 U.S.C. § 112

Claims 2, 18 and 32 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly being indefinite.

The Examiner stated that the claims 2, 18, and 32 fail to comply with the written description requirement. Specifically, the Examiner states that the unique identifier is *embedded* with specific manufacturing configuration of equipment.

However, a written description is provided in the application. The controller includes a unique identifier, which is assembled in a manner such that it provides the remote monitor with specific aspects or properties of the equipment. The specific properties of the equipment are embedded within the unique identifier. As seen in Table 1 and paragraph [0032], the unique

identifier can be assembled such that it provides the (i) Manufactured Month/Year;(ii) Shipped date;(iii) Device Brand;(iv) Device Feature Set;(v) Device Type; and vi) Operating limits.

As mentioned in paragraph 30, "The serial number is also referred as to a unique identifier." Furthermore, as mentioned in paragraph 32, "the serial number is compiled using a number of pieces of data that helps the apparatus 10 decode certain aspects of the equipment 14." The disclosure's statement that the unique identifier is compiled using the specific manufacturing configurations of the equipment, shows on the written record that the unique identifier is embedded or included with the specific manufacturing configurations of the equipment. Using the Standard IEEE dictionary, embedded simply means that the manufacturing information is part of the unique identifier. Furthermore, as the unique identifier is *compiled* using the data that helps the apparatus decode aspects of the equipment, a description has been properly given supported. As mentioned in MPEP 2163, "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." As shown above, it is clear that the inventor did have possession of the claimed invention. Therefore, the written description requirement has been met and the rejection should be removed.

Applicants respectfully submit that the rejection has been overcome and request that the rejection be withdrawn.

Docket No. 87289.1741
Application No. : 10/022,194
Customer No. 30734

Special Examination Procedures
Response to Final Office Action

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney to expedite the prosecution of the application at 202-861-1737.

The Applicants petition for a one (1) month extension of time in the amount of \$120.00. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87289.1741.

Respectfully submitted,

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